

Application No. 09/901,979

Applicants: Lutz Heuer et al.

Request for Reconsideration in response to Office Action dated June 3, 2003

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

Claims 7-15 are pending. Claims 8, 13 and 14 have been withdrawn from consideration. Claim 12 has been deemed allowable subject matter.

At the outset, Applicants thank the Examiner for removing the enablement rejection and stating that the Applicants are entitled to broad claims. Applicants also would like to thank the Examiner for indicating claim 12 is allowable subject matter.

Rejections under 35 U.S.C. 102(b) in view of U.S. Patent No. 4,664,696

The Examiner rejected claims 7, 9, and 15 under 35 U.S.C. 102(b) as being anticipated by Schaub (U.S. Patent No. 4,664,696). The Examiner found Schaub teaches a fungicidal composition comprising cyproconazole plus another azole fungicide such as benzimidazole (benomyl). In response, Applicants submit that the reference is not sufficiently focused enough to constitute an anticipation. Schaub actually teaches a fungicidal composition comprising (A) any of a large number of azole compounds - one of which is cyproconazole - plus (B) optionally a large number of further fungicides - one of which is benomyl.

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Schaub contains numerous examples, and not one of which is a specific combination of cyproconazole and benomyl. Respectfully Applicants submit that Schaub is too broad to anticipate the instant claims.

Further on this point, Applicants refer the Examiner to the final products of Schaub starting at the top of column 8 continuing over to the bottom of column 12, wherein Applicants count at least 36 azoles, any one of which can be combined with any other fungicide found in Schaub at column 7, lines 9-22, of which Applicants count at least 12 specific examples. Consequently, there are more than 432 possible combinations (36 x 12), only one of which is the combination of cyproconazole and benomyl. Applicants submit that over 432 possible combinations are too large of a genus, and that such a broad teaching is manifestly insufficient to constitute anticipation. *In re Rushig*, 145 USPQ 274, 282 (CCPA 1965) (130 compounds and 156 compounds not "a small recognizable class" so as to justify anticipation).

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) in view of U.S. Patent No. 5,373,013

Claims 7, 9, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hubele et al. (U.S. Patent No. 5,373,013).

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Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being obvious in view of the Hubele reference.

In response to both rejections based on Hubele, Applicants submit the Hubele is not prior art under 35 U.S.C. 102(b) or 35 U.S.C. 103(a). The application that matured into the Hubele patent is a division of serial no. 16,365 which was filed on February 11, 1993. Therefore, the effective U.S. filing date of Hubele is February 11, 1993. In contrast, the instant application claims priority ultimately to Germany application no. P 42 33 337.7 filed on October 5, 1992. In order to perfect Applicants' priority claim, attached is a copy of the certified English translation of the German priority document, a copy of which was filed in the parent application, U.S. Serial No. 08/128,450. Accordingly, Applicants are entitled to the benefit of the German priority application, and therefore, the invention date of the instant invention must be regarded as being as early as October 5, 1992. Since this date is prior to the effective U.S. filing date of Hubele, the Hubele reference is not prior art under 35 U.S.C. 102(b) and 35 U.S.C. 103(a).

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw these rejections. An early notice that these rejections have been reconsidered and withdrawn is, therefore, earnestly solicited.

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Conclusion

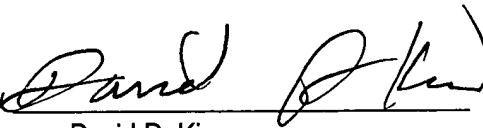
Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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Enclosure: Certified English translation of German priority document P 42 33 337.7